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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,131	01/26/2001	Satoshi Mizutani	2309/01213	6716
7590	07/14/2003			
DARBY & DARBY P.C. 805 Third Avenue New York, NY 10022			EXAMINER CHEVALIER, ALICIA ANN	
		ART UNIT 1772	PAPER NUMBER 16	
		DATE MAILED: 07/14/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/771,131	MIZUTANI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alicia Chevalier	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 April 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 and 10-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **RESPONSE TO AMENDMENT**

### ***Request for Continued Examination***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2003 has been entered.

Claims 8 and 9 remain withdrawn due to the earlier restriction requirement and election, papers 4 and 5.

### ***WITHDRAWN REJECTIONS***

2. The 35 U.S.C. §103 rejection of claims 1, 2, 4, 5, 7, 10 and 11 over Sorensen (4,327,730) in view of Gray et al. (5,660,788) of record in paper #9, pages 2-4, paragraph #6 have been withdrawn due to Applicant's amendment in paper #15.

3. The 35 U.S.C. §103 rejection of claims 3, 6 and 12 over Sorensen (4,327,730) in view of Gray et al. (5,660,788) and further in view of McCormack (5,955,187) of record in paper #9, pages 4-5, paragraph #7 have been withdrawn due to Applicant's amendment in paper #15.

### ***NEW REJECTIONS***

4. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The newly added limitation “uppermost portions of respective protrusions defining contact points only at locations where said top sheet comes into contact with a wear’s skin” is new matter. The limitation is constructed to mean that only the uppermost portions of the protrusions are in contact with the wear. The Examiner is unable to find support for this limitation in the specification or the drawings. Applicant’s response on page 5, the last paragraph, alleges that support may be found on page 11, line 20 thru page 12, line of the specification. Page 11, line 20 thru page 12, line of the specification recites:

“The load in compression of the protrusions 5, i.e., a LC value thereof preferably falls between 0.05 and 0.5. The LC value indicated the behavior of the protrusions under compression, and is measured by use of the texture feel tester, Katotec’s KES. If their LC value is smaller than the lowermost limit of the defined range, the protrusions will be readily crushed by the pressure of the body of wearers. If their LC value is larger than the upper most limit than the

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uppermost limit of the defined range, their compressive resistance will increase and therefore the protrusions will be hard."

This section of the specification only discusses how different load compressions will affect the top sheet, i.e. if the LC is too smaller the protrusions will be crushed and alternatively if the LC is too large the protrusion will fell hard. The section does not recite anything about how or where the top sheet contacts the wear. As such the limitation is deemed to be new matter and is required to be removed from the claims.

Upon removal of the new matter from the claims the 35 U.S.C. §103 rejections of record in paper #9 will be reapplied.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen (4,327,730) in view of Gray et al. (5,660,788).

Sorensen discloses a topsheet of an absorbent article useful in such articles as diapers, bandages, catamenials, and the like (col. 1, lines 9-16). The topsheet comprises a thermoplastic film, which is perforated and has a plurality of nubbles (protrusions) protruding from the body side of the topsheet (col. 3, line 66 to col. 4, line 32 and figure 3). The nubbles have a cross-sectional diameter of from about 0.0127 to about 0.279 mm and a height that is at least 30% of the cross-sectional diameter (greater than between 0.00381-0.0837 mm) (col. 4, lines 33-50).

The topsheet contacts the wearer's skin and is therefore preferably compliant, soft feeling, fluid permeable, and non-irritating to wearer's skin (col. 3, lines 66-68).

Sorensen discloses all the limitations of the instant claimed invention except for the topsheet further containing particulate material.

Gray discloses a topsheet for an absorbent article such as diapers, incontinent articles, sanitary napkins, and the like (col. 2, lines 15-16). The top sheet comprises a thermoplastic material which includes a particulate material embedded (convex portions) on the wearer-contacting surface of the web. The particulate material may be talc or clay. See column 5, lines 20-27 and lines 63-67. The addition of the particulate material to the wearer-contacting surface of the plastic topsheet reduces the plastic like feel associated with such films (col. 6, lines 7-16).

The topsheet is compliant, soft feeling and non-irritating to the wearer's skin (col. 4, lines 47-48).

Gray further discloses that the size of the particulate material is such that light incident upon the visible surface of the web is substantially diffused into a multiplicity of directions by the particulate material into a multiplicity of direction rather than being specularly reflected, thereby providing a non-glossy visible surface (col. 6, lines 1-6).

It would have been obvious to one of ordinary skill in the art to add the particulate material of Gray to the wearer-contacting surface of Sorensen's topsheet because the addition of the particulate material would reduce the plastic like feel associated with such films.

Gray does not disclose that the particulate material has a mean particle size in a range between 0.1 micrometer and 30 micrometer. However, the exact mean particle size is deemed to be a cause effective variable with regard to the ability of the particle to diffuse light and provided a softer feel. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such the mean particle size and amount through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d

1934, 1936 (Fed. Cir. 1990). One of ordinary skill would have been motivated to optimize the size range of the particle to 0.1 to 30 micrometers and amount because smaller particles would produce a smoother more uniform touch to the sheet.

#### ***ANSWERS TO APPLICANT'S ARGUMENTS***

8. Applicant's arguments regarding 103 rejections of claims 1-7 and 10-12 have been considered but are moot since the rejections have been withdrawn and the new grounds of rejection regarding the new matter.

9. Applicant's arguments regarding new claim 13 have been considered but are deemed unpersuasive.

Applicant argues that none of the cited references teach or suggest, the exact height of the protrusions and the particles. As shown in the rejection of claim 13 above, Sorensen specifically teaches the protrusion height of 0.004-0.08 mm, which reads Applicant's claimed range of 0.05 to 1.0 mm. Furthermore, as pointed out above Gray does not explicitly disclose that the particulate material has a mean particle size in a range between 0.1 micrometer and 30 micrometer. However, the exact mean particle size is deemed to be a cause effective variable with regard to the ability of the particle to diffuse light and provided a softer feel. It would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such the mean particle size and amount through routine experimentation in the absence of a showing of criticality in the claimed combined thickness. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). One of ordinary skill would have been motivated to optimize the size range of the particle to 0.1 to 30

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micrometers and amount because smaller particles would produce a smoother more uniform touch to the sheet.

In view of the above rejection all the claimed limitations of claim 13 have been met.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

7/11/03

*Alicia Chevalier*